



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/825,894 | 04/05/2001 | Oliver Mason Hopkins | 2685/5778 | 4487 |
| 23838 | 7590 | 10/27/2004 | EXAMINER | |
| KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005 | | | WILSON, ROBERT W | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2661 | |

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,894

Applicant(s)

HOPKINS, OLIVER MASON

Examiner

Robert W Wilson

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4/5/01</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2661

Detailed Action

1.0 The application of Oliver Mason Hopkins entitled METHOD FOR TIME-STAMPING A MESSAGE BASED ON A RECIPIENT LOCATION which was filed on 4/5/01 and claiming priority based upon CON of 08/868, 401 dated 6/3/97 was examined. Claims 1-2 & 7-10 are pending.

Claim Rejections - 35 USC § 102

2.0 following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3.0 **Claims 1-2** are rejected under 35 U.S.C. 102(e) as being anticipated by Milton et. al. (U.S. Patent No.: 5,631,949)

Referring to **Claim 1**, Milton teaches: A method for time-stamping a message to a mobile recipient (The word “mobile” only appears in the preamble and not the claim limitation; therefore, “mobile” is given no weight because it is interpreted as intended use. The messaging platform or message center time stamps all incoming messages per col. 2 line 24-col. 4 line 43 or Figs 2-3 or performs the method of time-stamping)

Receiving a message at a message center, the message intended for receipt by the given recipient (The message platform receives the call for the subscriber or recipient and converts the call to

Art Unit: 2661

digital and time stamps the message associated with a first time zone per col. 2 line 23-col. 4 line 44 or per Fig 2)

Determining the second time zone in which the mobile recipient is located (When the recipient later accesses the system in order to retrieve the message then the system determines the time zone in which the subscriber or recipient is located and translates the original time stamp into the subscriber or recipients zone per col. 2 line 23-col. 4 line 44)

Creating a time-stamp based on said second time stamp zone (When the subscriber or recipient later accesses the system in order to retrieve the message then the system determines the time zone in which the recipient is located and translates the original time stamp to the recipients zone per col. 2 line 23-col. 4 line 44)

In Addition Milton teaches:

Regarding **Claim 2**, comprising the further step of transmitting said message with said time-stamp from said message center to the recipient (The message platform or center sends the message to the subscriber or recipient with a time-stamp per col. 2 line 23-col. 4 line 44)

Claim Rejections - 35 USC § 103

4.0 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.0 **Claims 7-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Milton et. al. (U.S. Patent No.: 5,631,949) in view of Mechling et. al. (U.S. Patent No.: 5,873,030)

Referring to **Claim 7**, Milton teaches: A method for sending a time-stamped message to a mobile recipient (Figures 1-4 teach a method of sending a time stamped message to a subscriber or recipient), the method comprising the steps of:

Receiving a message at a message center in a first time zone (The message platform receives the call and converts the call to digital and time stamps the message associated with a first time zone per col. 2 line 23-col. 4 line 44 or per Fig 2)

Art Unit: 2661

Determining the second time zone in which the mobile recipient is located (When the recipient later accesses the system in order to retrieve the message then the system determines the time zone in which the recipient is located and translates the original time stamp into the subscriber or recipients zone per col. 2 line 23-col. 4 line 44)

Creating a time-stamp based on said second time stamp zone (When the subscriber or recipient later accesses the system in order to retrieve the message then the system determines the time zone in which the recipient is located and translates the original time stamp to the recipients zone per col. 2 line 23-col. 4 line 44) and

Sending said time-stamp and said message to the mobile recipient (The system sends the message to the subscriber or recipient per col. 2 line 23-col. 4 line 44)

Milton does not expressly call for: a mobile but teaches a subscriber receives a message or voice mail.

Mechling et. al. teaches : a mobile receives voice mail from a voice mail server 226 per Fig 2D and the mobile network is interconnected with both a local and long distance networks per Fig 1a.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the mobile of Mechling to the messaging of voice mail system of Milton in order to provide voice mail or messaging in a mobile network because voice mailing is a legacy function in long distance and local POTs networks which customers in mobile networks could not live without.

In Addition Milton teaches:

Regarding **Claim 8**, wherein the first and second time zones are different (The reference teaches that the message is translated from a first to a second time zone per col. 2 line 23-col. 4 line 44)

In Addition Mechling teaches:

Regarding **Claim 9**, where said step of determining said second time zone comprises the step of :

Determining a network node with which the mobile is registered (The primary reference teaches that the system utilizes the phone number of the subscriber or recipient in order to determine the translation for the timestamp. Mechling teaches: a VLR is utilized in order to determine the location of the Mobile station per Fig 112A-f per Fig 1A. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the VLR in order to determine the location of the Mobile station prior to assigning a translated timestamp.)

Regarding **Claim 10**, wherein said network switch comprises a switch providing wireless communication capabilities (The Mobile Switching Center 112A-F per Fig 1A inherently has a switch)

Art Unit: 2661

Double Patenting

6.0 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 & 7-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,239,719 B1.

Referring to **Claims 1 & 2**, U.S. Patent No.: 6,239,719 B1 teaches all of the limitations application Claims 1 & 2 in Claims 1-3 except that application calls for a recipient and the patent teaches a mobile. It would have been obvious to one of ordinary skill in the art at the time of the invention that the mobile of 6,239,719 B performs the same function as the recipient.

Referring to **Claims 7-10**, U.S. Patent No.: 6,239,719 B1 teaches all of the limitations of Claim 7-10

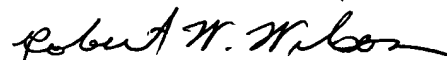
Conclusion

7.0 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W Wilson whose telephone number is 571/272-3075. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Vanderpuye can be reached on 571/272-3078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2661

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert W Wilson
Examiner
Art Unit 2661

RWW
October 18, 2004


KENNETH VANDERPUYE
PRIMARY EXAMINER